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No. 75-1846

In the
Supreme Court of the United States

OCTOBER TERM 1975

CMI CORPORATION,

Petitioner,

vs.

LAKELAND CONSTRUCTION CO., INC.,
and MILLER FORMLESS CO., INC.,

Respondents.

**BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

THEODORE W. ANDERSON

JAMES R. DOWDALL

77 West Washington Street

Chicago, Illinois 60602

Telephone: (312) 346-1200

Attorneys for Respondents

Of Counsel:

NEUMAN, WILLIAMS, ANDERSON & OLSON

77 West Washington Street

Chicago, Illinois 60602

Telephone: (312) 346-1200

BRUCE K. THOMAS

JOHNSON, DIENNER, EMRICH & WAGNER

150 North Wacker Drive

Chicago, Illinois 60606

Telephone: (312) 368-8575

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REASONS FOR DENYING THE WRIT

- 1. The Petition for Writ of Certiorari
Presents No New Issue of Law and No
Issue Of Public Importance.**

The petition for writ of certiorari should be denied. It does nothing more than seek to have this Court reevaluate the evidence and retry issues decided correctly and adversely to CMI by the Courts below. There is no constitutional law question presented. There is no conflict with any decision of this Court or of another Court of Appeals, and there is no special or important reason within the contemplation of Supreme Court Rule 19(1) for granting the petition. This case is a routine

one in which the District Court properly struck down a patent that was clearly invalid in a judgment which, on appeal, was unanimously affirmed on holdings of both invalidity and non-infringement.

The patent in suit (hereinafter designated the '026 patent) is nothing more than a "paper patent" since the construction machine illustrated and described therein has never been built, tested, manufactured or sold, nor was it ever proven to be of sound design (Finding 18, App. 14).^{*} Rather than commercializing the '026 machine, petitioner asserted the patent against totally different and eminently successful commercial structures independently developed by respondents prior to any awareness of the '026 patent.

**2. CMI's Reasons For
Allowance of Writ Lack Merit.**

**A. The Court of Appeals' Decision
Does Not Conflict with Cases
Decided by the Supreme Court.**

In its unpublished opinion (Appendix C, App. 3) the Court of Appeals not only recognized that the District Court had made findings of fact "with great care" (App. 4) but also further emphasized:

"With respect to obviousness, the court concluded that because of prior art not considered by the Patent Office, the claims in suit do not enjoy the statutory presumption of validity, and that a person skilled in the art would have found the claimed combination obvious. The findings fully complied with the requirements of *Graham v. John Deere Co.*, 383 U.S. 1

^{*} Throughout this Brief the following references will be used:

The Petition (Pet.)

The Petitioner's Appendix (App.) substituting Arabic numbers for Roman numerals used by Petitioner.

(1966). Appellant has not persuaded us that any finding of fact is clearly erroneous, nor that the conclusion of obviousness is an error." (App. 4)

The requirements of *Graham v. John Deere Co.* were reaffirmed in *Anderson's Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U.S. 57, 62 (1969) and were reiterated by this Court as recently as April 20, 1976 in *Sakraida v. Ag Pro, Inc.* U.S., 189 USPQ 449. In the present case, the obviousness determination by the District Court, and the affirmance by the Court of Appeals, were a recognition of the manifest weight of the credible evidence and demonstrated that each court was perceptively aware of both the proper legal standards established by 35 U.S.C. § 103 and the *Graham* guidelines.

**B. The Disclosure of CMI's Earlier Patent Was
Not Included as Prior Art.**

CMI is fundamentally wrong in stating that the District Court included the disclosure of its earlier patent as part of the prior art. Precisely the contrary is true. The Court specifically held that "the complete disclosures of copending applications of the same inventors are not prior art as to each other" (Finding 33, App. 19).

Having built a faulty premise, CMI asserts that it is a matter of long standing law in the lower courts that a patentee's prior patent is not prior art within the meaning of 35 U.S.C. § 103 when the application for the prior patent was pending at the time the application for the patent-in-suit was filed (Pet. 4). The assertion is a *non sequitur* because the District Court and Court of Appeals clearly recognized and acknowledged that the entire disclosure was not prior art, and dealt only with the claims

of the earlier '846 patent (App. 19). CMI's assertion, if it is a reference to the *claims* of the prior patent, is directly contrary to the controlling weight of authority. It is well settled that where two similar patents issue to the same patentee on applications that were co-pending, the claims of the first issued patent constitute prior art against the second patent as to what is claimed therein. *Triax Company v. Hartman Metal Fabricators, Inc.*, 479 F.2d 951, 954 (2 Cir. 1973); *Application of Ornitz*, 457 F.2d 586, 590 (CCPA 1965); *Intricate Metal Products, Inc. v. Schneider*, 324 F.2d 555, 560 (9 Cir. 1963).

CMI's earlier '846 patent is notably absent from Finding 19 in which the "prior art" is enumerated and recited as negating the usual presumption of validity (App. 15). In view of Finding 19 it is clear the court is referring to the '846 claims when it includes developments evidenced by that patent as the last of a long enumeration of prior art in Finding 72 (App. 27). The District Court there expressly found that measured against the prior art there are no "differences" claimed in the '026 patent within the meaning of the *Graham v. Deere* obviousness test.

Certainly there is no logical reason to suppose, as CMI speculatively suggests (Pet. 4), that the District Court "relied heavily" on the '846 patent and that the exclusion of that patent from the prior art would dramatically alter the "obviousness" determination. A contrary conclusion that the '846 patent was merely an incidental inclusion is far more consistent with the Findings as a whole.

C. Filing A Terminal Disclaimer Cannot Justify Two Patents On A Single Invention.

CMI is wrong in stating that the lower courts did not dispute CMI's position that a terminal disclaimer overcame double patenting (Pet. 5).

The District Court expressly found that the filing of a terminal disclaimer was ineffective since disclaiming in this case cannot avoid the invalidity of the later filed patent to the same subject matter (Finding 35, App. 20). This finding was consistent with recognized authority. *Hays v. Brenner*, 357 F.2d 287 (D.C. Cir. 1966); *C-Thru Products, Inc. v. Uniflex, Inc.*, 262 F.Supp. 213 (E.D. N.Y. 1966), aff'd 397 F.2d 952 (2 Cir. 1968).

Furthermore, CMI is wrong in suggesting that the Court's holding of double patenting was based on the fact that CMI filed its terminal disclaimer on the eve of trial (Conclusion 13, App. 40).

CMI's arguments (Pet. 5) relative to the terminal disclaimer and double patenting issues are unfounded, do not warrant review by this Court and, in any event, do not vitiate the compelling fact that the subject of both patents was clearly obvious. To avoid the defense of double patenting it is not enough that there be mere differences between the claims of the two patents involved but the differences must rise to the level of patentable invention. *Weatherhead Company v. Drillmaster Supply Co.*, 227 F.2d 98, 102 (7 Cir. 1955); *Graham-White Sales Corp. v. Prime Manufacturing Co.*, 237 F.Supp. 694, 707 (E.D. Wis. 1964), aff'd per curiam, 343 F.2d 534 (7 Cir. 1965); *Briggs v. M & J Diesel Locomotive Filter Corp.*, 342 F.2d 573, 577 (7 Cir. 1965). The sound *Weatherhead* rationale has been consistently followed by the other Circuits.

The laudatory effect of this Court's decision in *Blonder-Tongue Laboratories Inc. v. University of Illinois Foundation*, 402 U.S. 313 (1971) was to limit a patent owner to one unsuccessful attempt to sustain the validity of *one patent on one invention*. If the courts were to permit two patents on one invention, even provided they expire on the same day, the doctrine of the *Blonder-Tongue* case would be defeated and futile and costly litigation would be compounded.

**D. There Is No Reason To Review
The Holding Of Non-Infringement.**

The manifest weight of the credible evidence established the existence of substantial differences in means, operation and results between the accused machines and the claimed structure of the patent in suit. These differences are embodied in comprehensive Findings 98-104 (App. 33-35). Ignoring the evidence, CMI weakly argues (Pet. 5-6) that infringement was established on the theory that four track and two track assemblies were "well-known to be interchangeable in the pertinent art." (Pet. 5) The District Court found that the four-track system of the accused device is fundamentally different in structure and function from the two-track system of the patent in suit and is not merely a splitting of one device into two (Finding 102, App. 34). The Court of Appeals affirmed, stating:

"The court found sufficient real difference in structure and function between the accused machines and the claims so that the doctrine of equivalents is not applicable. The principal difference arises out of the four endless track system of the accused machines, and the steering capabilities resulting from their arrangement, as compared to the two endless track system of the 3,249,026 patent." (App. 5)

CMI's reliance on *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950) is misplaced. The decisions below are in complete accord with the law expressed in *Graver Tank* in which it was held:

"Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. *Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537, 568."

CONCLUSION

For the foregoing reasons the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

THEODORE W. ANDERSON

JAMES R. DOWDALL

77 West Washington Street

Chicago, Illinois 60602

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